

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	§	Group Art Unit: 2154
Rahul L. Shah	§	
	§	Examiner: Naurot Ton, Joan B.
Serial No. 10/670,849	§	
	§	Atty. Dkt. No.: 5681-69900
Filed: September 25, 2003	§	
	§	
	§	
For: Method and System for	§	
Processing Instant Messenger	§	
Operations Dependent Upon	§	
Presence State Information in	§	
an Instant Messaging System	§	

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Anthony M. Petro

Printed Name

/Anthony M. Petro/

Signature

January 29, 2008

Date

**APPEAL BRIEF**

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir/Madam:

Further to the Notice of Appeal filed November 29, 2007, Appellant presents this Appeal Brief. Appellants respectfully request that the Board of Patent Appeals and Interferences consider this appeal.

**I. REAL PARTY IN INTEREST**

As evidenced by the assignment recorded at Reel/Frame 014545/0967, the subject application is owned by Sun Microsystems, Inc., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at 4150 Network Circle, Santa Clara, CA, 95054.

## **II. RELATED APPEALS AND INTERFERENCES**

No other appeals, interferences or judicial proceedings are known which would be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### **III. STATUS OF CLAIMS**

Claims 1-57 are pending in the application and stand finally rejected. The rejection of claims 1-57 is being appealed. A copy of claims 1-57 is included in the Claims Appendix hereinbelow.

#### **IV. STATUS OF AMENDMENTS**

No amendments to the claims, specification, or drawings have been filed subsequent to the final rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a computer-implemented method comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline (*see, e.g.*, FIG. 6, block 500; and p. 40, lines 1-8).

The method of claim 1 further includes determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user (*see, e.g.*, FIG. 6, block 502; and p. 40, lines 10-13).

The method of claim 1 also includes selectively processing said instant messaging operation dependent upon said presence state in response to said determining (*see, e.g.*, FIG. 6, block 504; and p. 40, lines 15-18).

Independent claim 11 is directed to a computer-implemented method, comprising storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user (*see, e.g.*, FIG. 8, block 700; and p. 44, lines 2-9).

The method of claim 11 further includes detecting a transition to said given presence state subsequent to said storing (*see, e.g.*, FIG. 8, block 702; and p. 44, lines 11-14).

The method of claim 11 also includes performing said instant messaging operation in response to said detecting (*see, e.g.*, FIG. 8, block 704; and p. 44, lines 16-20).

Independent claim 20 is directed to a computer-accessible storage medium comprising program instructions (*see, e.g.*, FIG. 3, memory 210, code 215; and p. 21, line 18 – p. 22, line 2, p. 25, lines 9-24).

The program instructions of claim 20 are computer-executable to receive an instant messaging operation directed to a given user, wherein said given user is not offline (*see, e.g.*, FIG. 6, block 500; and p. 40, lines 1-8, p. 37, line 27 – p. 38, line 3).

The program instructions of claim 20 are further computer-executable to determine a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user (*see, e.g.*, FIG. 6, block 502; and p. 40, lines 10-13, p. 38, lines 4-15).

The program instructions of claim 20 are also computer-executable to selectively process said instant messaging operation dependent upon said presence state in response to said determining (*see, e.g.*, FIG. 6, block 504; and p. 40, lines 15-18, p. 38, line 17 – p. 39, line 4).

Independent claim 30 is directed to is directed to a computer-accessible storage medium comprising program instructions (*see, e.g.*, FIG. 3, memory 210, code 215; and p. 21, line 18 – p. 22, line 2, p. 25, lines 9-24).

The program instructions of claim 30 are computer-executable to store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user (*see, e.g.*, FIG. 8, block 700; and p. 44, lines 2-9, p. 41, line 28 – p. 42, line 5).

The program instructions of claim 30 are further computer-executable to detect a transition to said given presence state subsequent to said storing (*see, e.g.*, FIG. 8, block 702; and p. 44, lines 11-14, p. 42, lines 20-24).

The program instructions of claim 30 are also computer-executable to perform said instant messaging operation in response to said detecting (*see, e.g.*, FIG. 8, block 704; and p. 44, lines 16-20, p. 42, lines 24-27).

Independent claim 39 is directed to a system (*see, e.g.*, FIG. 2, system 12; p. 19, lines 13-17) comprising a computer system (*see, e.g.*, FIG. 2, computer system 20b; p. 19, lines 19-28, p. 20, lines 2-3) and an instant messenger software module configured to execute on said computer system (*see, e.g.*, FIGs. 1-2, instant messenger client 100a; p. 9, lines 15-26).

The instant messenger software module of claim 39 is configured to receive an instant messaging operation directed to a given user, wherein said given user is not offline (*see, e.g.*, FIG. 6, block 500; and p. 40, lines 1-8, p. 37, line 27 – p. 38, line 3).

The instant messenger software module of claim 39 is further configured to determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user (*see, e.g.*, FIG. 6, block 502; and p. 40, lines 10-13, p. 38, lines 4-15).

The instant messenger software module of claim 39 is also configured to selectively process said instant messaging operation dependent upon said presence state in response to said determining (*see, e.g.*, FIG. 6, block 504; and p. 40, lines 15-18, p. 38, line 17 – p. 39, line 4).

Independent claim 49 is directed to a system (*see, e.g.*, FIG. 2, system 12; p. 19, lines 13-17) comprising a computer system (*see, e.g.*, FIG. 2, computer system 20b; p. 19, lines 19-28, p. 20, lines 2-3) and an instant messenger software module configured to execute on said computer system (*see, e.g.*, FIGs. 1-2, instant messenger client 100a; p. 9, lines 15-26).

The instant messenger software module of claim 49 is configured to store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user (*see, e.g.*, FIG. 8, block 700; and p. 44, lines 2-9, p. 41, line 28 – p. 42, line 5).



The instant messenger software module of claim 49 is further configured to detect a transition to said given presence state subsequent to said storing (*see, e.g.*, FIG. 8, block 702; and p. 44, lines 11-14, p. 42, lines 20-24).

The instant messenger software module of claim 49 is also configured to perform said instant messaging operation in response to said detecting (*see, e.g.*, FIG. 8, block 704; and p. 44, lines 16-20, p. 42, lines 24-27).

The summary above describes various examples and embodiments of the claimed subject matter. However, the claims are not necessarily limited to any of these examples and embodiments. The claims should be interpreted based on their respective wording.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1-5, 7, 9, 10-16, 18-24, 26, 28-35, 37-43, 45, 47-54, and 56-57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McDowell et al. (U.S. Patent Application Publication No. 2002/0035605).

2. Claims 1, 8, 11, 17, 20, 27, 30, 36, 39, 46, 49, and 55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Aravamudan et al. (U.S. Patent 6,301,609).

3. Claims 6, 25, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDowell et al. (U.S. Patent Application Publication No. 2002/0035605) in view of Generous et al. (U.S. Patent Application Publication No. 2002/0120697).

In addition, various ones of the claims stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting in view of claims of copending Applications No. 10/670,550 and 10/670,549. However, Appellants submit that because these rejections remain provisional (i.e., neither of the referenced applications has issued as a patent), they are not yet ripe for review by the Board of Patent Appeals and Interferences.

## VII. ARGUMENT

### First ground of rejection:

The Examiner rejected claims 1-5, 7, 9, 10-16, 18-24, 26, 28-35, 37-43, 45, 47-54, and 56-57 under 35 U.S.C. § 102(b) as being anticipated by McDowell et al. (U.S. Patent Application Publication No. 2002/0035605) [hereinafter McDowell]. Appellant respectfully traverses this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

### Claims 1-3, 20-22, and 39-41:

Regarding claim 1, contrary to the Examiner's assertion, McDowell fails to teach or suggest a method comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining.

In rejecting claim 1, the Examiner cites McDowell as disclosing "the integration of presence determination, location determination, [and] instant messaging." Office Action at 22 (quoting McDowell at para. 14). The Examiner also refers to McDowell's Table 1 as disclosing "several presence states which are not offline," *id.*, and asserts that McDowell's disclosure regarding "query[ing] the presence server 112 before attempting to send a message, eliminating inefficient retry attempts," McDowell at para. 53, discloses "selectively processing the instant messaging operation" as recited in claim 1, Office Action at 22. The Examiner finally asserts that McDowell's Table 5 discloses that users may indicate days and times they do not wish to "receive messages," and concludes that this discloses that "a user can have his phone on and be in a state that is not offline while deciding to be in a busy presence state and not receive messages." *Id.* Appellant

traverses the Examiner's assertions and notes that McDowell fails to anticipate claim 1 for at least the following reasons.

**1. McDowell fails to disclose determining a presence state of an instant messenger in response to receiving an instant messaging operation.**

Contrary to the Examiner's assertion, the states disclosed by McDowell in Table 1 are not presence states of an instant messenger, as required by claim 1, but instead are states that are specific to a particular wireless or mobile device. McDowell at para. 34, 45. Column 1 of Table 1 specifically refers to wireless device status. While Table 1 provides for a wireless device status that includes a user defined state, it remains the case that this state is a presence state of a wireless device and not an instant messenger.

The fact that McDowell distinguishes wireless device status as a distinct type of presence information is evident from the ON – WAP state, which specifically is defined as “phone is ON and subscriber is using the WAP instant messaging application.” If table 1 disclosed presence states of an instant messenger, then instant messaging would be relevant to all of the states listed in Table 1. Instead, McDowell calls out one particular device state as indicative of the case that an instant messaging application is being used, thus indicating that instant messaging is in fact not relevant to the other listed device states.

In Table 2 and at paragraphs 59–62, McDowell describes several “internet presence” states. However, McDowell does not disclose that any of these states is determined in response to receiving an instant messenger operation. Instead, McDowell states that to determine internet presence, “[t]he Presence Server communicates peer-to-peer with IM servers.” McDowell at para. 62. McDowell does not disclose that such communication occurs in response to receiving an IM operation. In fact, in the only indication McDowell appears to provide regarding the timing with which presence information is accessed, McDowell states that “[t]he Campaign Manager queries the Presence Server to know if a particular subscriber's phone is ON or OFF before

attempting to send a targeted mobile commerce message.” McDowell at 56, emphasis added. Apart from the differences in the type of presence information and the type of messaging involved, querying for device status before sending a message suggests the opposite timing from that required by claim 1, in which an instant messenger presence state is determined in response to receiving an instant messaging operation.

In response to the foregoing, the Examiner refers in the Advisory Action to claim 4 of McDowell, asserting that this discloses that “the instant messaging uses the presence module for presence information, and that presence information is maintained.” Appellant traverses the Examiner’s assertion and note that McDowell’s claim 4 specifically provides for “an instant messaging module connected to provide instant messaging service for the wireless subscribers utilizing the data concerning network presence.” (emphasis added) As established above, McDowell’s “network presence” is not equivalent to the instant messenger presence state recited in claim 1. Moreover, nothing in McDowell suggests that “network presence” is determined in response to receiving an instant messaging operation, a specifically enumerated aspect of claim 1 not addressed by the Examiner in either the Final Action or the Advisory Action.

**2. McDowell fails to disclose selectively processing an instant messaging operation dependent upon an instant messenger presence state in response to determining the presence state.**

The Examiner asserts that McDowell’s statement in paragraph 53, regarding querying the presence server prior to attempting to send a message, discloses selective processing of an instant messaging operation as recited in claim 1. Appellant disagrees. As noted above, McDowell fails to disclose determining a presence state of an instant messenger in the manner required by claim 1. More specifically, as noted above, McDowell distinguishes device-level status information from instant messenger presence state information. At paragraph 53, McDowell is referring not to presence state information of an instant messenger, but to the ON/OFF device-level status information referred to in Table 1. Thus, to the extent McDowell discloses any type of selective

processing, it is selective processing dependent upon the state of a device, not presence state of an instant messenger, as required by claim 1.

As to McDowell's disclosure in Table 5 regarding the ability of users to indicate days and times they do not wish to "receive messages," the items reflected in Table 5 are not indicative of presence state of an instant messenger. Instead, they are privacy preferences that are managed by subscribers through a "Privacy Management System" accessible via a secure Web or WAP interface. McDowell at para. 130–132. These items simply have nothing to do with presence state of an instant messenger. Rather, they represent a different class of information (privacy information) upon which information delivery may be conditioned. Simply because McDowell may disclose that delivery of a message may be contingent upon some sort of state, such as privacy information or device status information, does not entail that McDowell discloses selective processing of an instant message dependent upon a presence state of an instant messenger, as recited in claim 1.

In the Advisory Action, the Examiner responds to the foregoing by referring to paragraph 129 of McDowell and reiterating that this discloses selective processing of messages in response to determination of the presence state. Appellant traverses the Examiner's assertion and note that paragraph 129 is related to the privacy preferences discussed above. As noted previously, privacy preferences that condition message delivery are not equivalent to performing selective processing of instant messaging operations dependent upon a presence state of an instant messenger.

Appellant notes that that anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P. 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In view of the substantial omissions in McDowell noted above with respect to the independent claims, McDowell clearly fails to

meet the standard of anticipation. Similar arguments apply to similar independent claims 20 and 39. Therefore, Appellant submits that the rejections of claims 1, 20, and 39 are unsupported by McDowell. Appellant notes that the remaining cited references fail to remedy the omissions of McDowell with respect to the independent claims.

**Claims 4, 23, and 42:**

In addition to the reasons given above with respect to claim 1, McDowell further fails to teach or suggest that the recited instant messaging operation comprises **a poll operation**, as recited in claim 4. In rejecting claim 4, the Examiner refers to paragraph 41 of McDowell, which refers to making “interest information” available to merchants. The Examiner asserts that this discloses polling of subscribers to obtain the interest information. Office Action at 23. Appellant traverses the Examiner’s assertion. Merely making interest information available to merchants, as described at paragraph 41 of McDowell, suggests nothing regarding how such information is obtained. In particular, McDowell does not describe the collection of interest information as having anything to do with instant messaging operations. Finally, McDowell makes no mention whatsoever regarding an instant messaging poll operation such as that required by claim 4.

For at least these reasons, Appellant submits that the rejections of claim 4 and similar claims 23 and 42 are unsupported.

**Claims 5, 24, and 43:**

In addition to the reasons given above with respect to claim 1, McDowell further fails to teach or suggest that selectively processing said instant messaging operation dependent upon said presence state further comprises notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and **queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state**, as required by claim 5.

In rejecting claim 5, the Examiner refers to paragraph 155 and Table 5 of McDowell and asserts that “McDowell also uses a queuing algorithm for the messages to be sent . . . and also does not try to deliver messages when the user is busy since the user can set preferences to receive messages only at certain times.” Office Action at 23. Appellant disagrees that the teachings of McDowell amount to a disclosure of the features of claim 5. Specifically, while McDowell mentions that a user may set preferences about times during which to receive marketing messages, as shown in Table 5, McDowell does not disclose what happens to messages that are attempted to be sent to a user during a time that the user prefers not to receive them. That is, McDowell is silent as to whether such messages are discarded, queued, or simply not generated in the first place. More particularly, McDowell does not disclose the case recited in claim 5, in which an instant messaging operation **is queued without notifying said given user if the presence state is indicative of a busy user state**.

For at least these reasons, Appellant submits that the rejections of claim 5 and similar claims 24 and 43 are unsupported.

#### **Claims 7, 26, and 45:**

In addition to the reasons given above with respect to claim 1, McDowell further fails to teach or suggest **detecting a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notifying said given user of a queued instant messaging operation in response to detecting said transition**, as required by claim 7.

In rejecting claim 7, the Examiner refers to Table 1 of McDowell as disclosing the recited presence state transition and to paragraph 155 of McDowell as disclosing “a queuing algorithm which sends messages to a user in an instant messaging operation.” Office Action at 24. Appellant traverses the Examiner’s assertions. As noted above with respect to claim 1, the states disclosed in Table 1 are not presence states of an instant messenger. Further, while McDowell makes general mention of message queuing,



McDowell does not disclose any aspect of notifying a given user of a queued instant messaging operation in response to detecting a particular type of presence state transition. More generally, McDowell omits discussion of any action that may be taken in response to detecting a transition of presence state. Appellant notes that claim 7 does not merely recite actions that are taken independently of one another, but actions that have a causal (i.e., responsive) relationship. McDowell fails to disclose this relationship.

For at least these reasons, Appellant submits that the rejections of claim 7 and similar claims 26 and 45 are unsupported.

**Claims 9, 28, and 47:**

In addition to the reasons given above with respect to claim 1, McDowell further fails to teach or suggest storing schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; querying said schedule information; and **if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying**, wherein said current presence state and said different presence state each correspond to said given user, as required by claim 9.

In rejecting claim 9, the Examiner asserts that McDowell, Table 5 discloses the use of calendar information, that paragraph 53 discloses that a campaign manager queries a presence server to determine whether a phone is on or off, and that a user can change current presence state to a different presence state according to Tables 1 and 2. Office Action at 24. Appellant disagrees that any of these features or the remainder of McDowell amount to a disclosure of the features of claim 9. Specifically, Appellant notes that claim 9 does not merely recite that the presence state is changed, but that the **presence state is changed in a manner that is dependent upon activity status that is indicated in schedule information**. Even if, *arguendo*, McDowell discloses schedule

information and the possibility of a user changing his or her presence state, McDowell fails to disclose that presence state information is changed dependent upon schedule information, and more particularly, dependent upon an activity status indicated in schedule information, as required by claim 9.

For at least these reasons, Appellant submits that the rejections of claim 9 and similar claims 28 and 47 are unsupported.

**Claims 10, 29, and 48:**

In addition to the reasons given above with respect to claim 1, McDowell further fails to teach or suggest the features of claim 10. Appellant notes that the features of dependent claim are similar to those of independent claim 11, and submits that the rejections of claim 10 and similar claims 29 and 48 are unsupported for at least the reasons given below with respect to claim 11.

**Claims 11-15, 30-34, and 49-53:**

**Regarding claim 11, McDowell fails to teach or suggest a method comprising storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.**

In rejecting independent claim 11, the Examiner asserts that at paragraph 53, McDowell discloses that a short message service (SMS) center may “query the Presence Server . . . before attempting to send a message, eliminating inefficient retry attempts” and asserts that “[i]t is inherent that the message must have been stored in order to send it later.” Office Action at 25. The Examiner further refers to Table 5 of McDowell and asserts that this discloses that “a user can have his phone turned on and be in a state that

is not offline while deciding to be in a busy presence state and not receive messages.” *Id.* Appellant traverses the Examiner’s remarks for at least the following reasons.

**1. McDowell does not disclose storing an instant messaging operation associated with a given presence state.**

The Examiner’s statement that McDowell’s querying of the presence server prior to sending a message entails that the message is inherently stored is simply incorrect. It is equally consistent with this feature of McDowell that in response to the query of the presence server, the message may never be generated in the first place (e.g., if the query indicates that the user’s device is offline). McDowell is silent as to whether a message is generated and stored or simply not generated in this case. However, since more than one possibility is consistent with the teachings of McDowell, it is improper to say that any of these possibilities follows necessarily and inherently from McDowell.

Moreover, at paragraph 53, McDowell is describing the processing of Short Message Service (SMS) operations. SMS operations are not identical to or suggestive of instant messaging operations; they are a distinct species of operation. Thus, McDowell’s operation with respect to SMS operations is irrelevant to the question of the processing of instant messaging operations, as recited in claim 11.

Regardless of the accuracy of the Examiner’s statement regarding the “inherency” of McDowell’s storing a message, Appellant notes that claim 11 does not merely recite that an instant message is stored, but that an instant messaging operation is stored. Further, the stored operation is associated with a given presence state of an instant messenger. McDowell simply fails to disclose that there is any type of association between a stored instant messaging operation and a given presence state. Appellant refers to similar arguments made above with respect to claim 1 as to McDowell’s failure to disclose the recited instant messenger presence state.

In response to the foregoing, in the Advisory Action the Examiner refers to paragraph 98 of McDowell and asserts that this discloses “stored instant messages and other instant messaging operations such as saving an instant message as well as sending it.” Appellant submits that the Examiner has misread paragraph 98 in view of the language of claim 11. Paragraph 98 mentions storing messages, as well as reading, sending, composing, saving, or deleting messages. Storing a message is simply not identical to or suggestive of storing an instant messaging operation itself. The two entities are different in kind. While McDowell mentions various operations that may take place on a message, McDowell makes no mention of storing an instant messaging operation.

**2. McDowell fails to disclose detecting a transition to the given presence state or responsively performing the stored instant messaging operation.**

The Examiner does not address these features of claim 11 in either the Final Action or the Advisory Action. However, McDowell is completely silent as to the required claim features of detecting a transition to a given presence state. Moreover, McDowell does not disclose any aspect in which in response to detecting such a presence state transition, a stored instant messaging operation that is associated with the given presence state (i.e., the presence state to which a transition was detected) is then performed.

The features of McDowell’s Table 5 do not amount to a demonstration of the recitations of these features of claim 11. Even if a user of McDowell’s system “decide[s] to be in a busy presence state and not receive messages,” as asserted by the Examiner, this amounts only to a disclosure of a static state, not a transition from one state to another. Appellant notes that claim 11 requires that a stored instant messaging operation that is associated with a given presence state be performed in response to detecting a transition to the given presence state. Such transition detection triggering responsive performance of instant messaging operations is simply unknown in McDowell.

Appellant also refers to arguments given above with respect to claim 7 as to McDowell's failure to disclose actions taken in response to detecting a transition in presence state.

Because McDowell fails to disclose numerous features of claim 11 as set forth above, McDowell cannot be said to anticipate claim 11. Similar arguments apply to similar independent claims 30 and 49. For at least these reasons, Appellant submits that the rejections of these independent claims are unsupported by McDowell. Appellant notes that the remaining cited references fail to remedy the omissions of McDowell with respect to the independent claims.

**Claims 16, 35, and 54:**

In addition to the reasons given above with respect to claim 11, Appellant further submits that McDowell fails to teach or suggest that the recited instant messaging operation comprises a **poll operation**, as recited in claim 16. Appellant refers to arguments given above with respect to claim 4, which apply with equal force to similar claims 16, 35, and 54, and submits that for at least these reasons, the rejections of claims 16, 35, and 54 are unsupported.

**Claims 18, 37, and 56:**

In addition to the reasons given above with respect to claim 11, Appellant further submits that McDowell fails to teach or suggest the features recited in claim 18. Appellant notes that these features are similar to those recited in claim 9, and notes that the arguments given above with respect to claim 9 apply with equal force to similar claims 18, 37, and 56. Appellant therefore submits that the rejections of these claims are unsupported.

**Claims 19, 38, and 57:**

In addition to the reasons given above with respect to claim 11, Appellant further submits that McDowell fails to teach or suggest the features recited in claim 19. Appellant notes that these features are similar to those recited in claim 1, and notes that the arguments given above with respect to claim 1 apply with equal force to similar claims 19, 38, and 57. Appellant therefore submits that the rejections of these claims are unsupported.

**Second ground of rejection:**

The Examiner rejected claims 1, 8, 11, 17, 20, 27, 30, 36, 39, 46, 49, and 55 under 35 U.S.C. § 102(b) as being anticipated by Aravamudan et al. (U.S. Patent 6,301,609) [hereinafter Aravamudan]. Appellant respectfully traverses this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

**Claims 1, 8, 20, 27, 39, and 46:**

**Regarding claim 1, contrary to the Examiner's assertion, Aravamudan fails to teach or suggest a method comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining.**

In rejecting claim 1, the Examiner cites Aravamudan as disclosing "instant messaging with presence detection" at col. 7, lines 15-16. Office Action at 47. The Examiner further asserts that Aravamudan discloses selective processing of messages, referring to Aravamudan's priority assignment scheme discussed at col. 2, paragraph 2.

*Id.* Finally, the Examiner refers broadly to Figures 6 and 8 and col. 8, lines 64-68, col. 9, lines 10-20 and col. 9, lines 25-35 of Aravamudan as disclosing “presence states that are not offline and for which the active and inactive states which are not offline have messages which are selectively processed.” *Id.* Appellant traverses the Examiner’s assertions and notes that Aravamudan fails to anticipate claim 1 for at least the following reasons.

**1. Aravamudan fails to disclose determining a presence state of an instant messenger in response to receiving an instant messaging operation.**

First, and most generally, Aravamudan does not disclose any aspect of determining a presence state of an instant messenger. Aravamudan describes that a CPE device monitors for general user activity, and if such activity is detected, the CPE device generates and conveys an active message to the CSP via an IM server. Aravamudan makes no mention whatsoever of presence states of an instant messenger. To the extent Aravamudan describes “state” at all, it is in broadly referring to the state of the entire CPE device, e.g., as active or inactive, based on the monitored user interaction with the device. In Aravamudan, detected user interaction and the corresponding active message are specific to the CPE device as a whole, not to an instant messenger that might be executing on that device. Thus, Aravamudan speaks of a user being either “online” or “offline” with respect to the CPE device.

To the extent that Aravamudan discusses state information with respect to an instant messenger, it is with respect to establishing “buddy groups.” *E.g.*, col. 2, lines 34-36. However, “buddy groups” in Aravamudan refer to the identities of various users of the instant messenger, not to their presence states within an instant messaging system. In response to the foregoing, in the Advisory Action, the Examiner refers to col. 3, lines 20-21. This section describes the contents of FIG. 9 as illustrating a method of maintaining a “continuous user network presence” for a number of buddies (emphasis added). However, in Aravamudan’s system, “network presence” refers to the device presence

discussed above; i.e., whether a user is online or offline with respect to the network as a whole. It does not refer to a presence state of an instant messenger.

Also, Aravamudan fails to disclose that presence state is determined in response to receiving an instant messaging operation. With regard to the Examiner's reference to col. 7, lines 15-16, in which Aravamudan discloses that "[t]he IM server also notifies selected buddies to the user of the user[']s presence online," Appellant notes that this activity occurs in response to the user's initially logging on to the network, not receipt of an instant messaging operation. Aravamudan at col. 6, line 64 – col. 7, line 3.

Appellant further notes that Aravamudan describes a situation in which an "important event" is received and an instant message corresponding to the event is responsively generated. *Id.* at col. 8, line 32 – col. 9, line 44. However, out of a number of enumerated possibilities to which such an important event could correspond, Aravamudan specifically omits to mention receiving an instant messaging operation. Appellant notes that generating an instant message in response to an important event, as in Aravamudan, is not suggestive of determining a presence state of an instant messenger, as required by claim 1.

**2. Aravamudan fails to disclose selectively processing an instant messaging operation dependent upon an instant messenger presence state in response to determining the presence state.**

The Examiner suggests that Aravamudan's "notify[ing] selected buddies" corresponds to selectively processing an instant messaging operation. However, as noted above, this discussion of Aravamudan describes what occurs in response to the user's initially logging on to the network. In this instance, there is simply no instant messaging operation to be selectively processed. Further, as noted above, Aravamudan does not perform such notification dependent upon an instant messenger presence state, but rather on a device state.



The Examiner further asserts that Aravamudan's discussion regarding assigning various levels of priority to different users (as mentioned at col. 2, paragraph 2, and in greater detail at col. 9, line 45 – col. 11, line 5) discloses selective processing of instant messaging operations. However, the assignment of priorities to various "buddies" simply has nothing to do with selective processing of instant messaging operations dependent upon an instant messenger presence state. In Aravamudan, the priorities assigned by a user to his/her various buddies are entirely dependent upon that user's preferences regarding the buddies. Such preferences reflect the relative importance of various ones of the user's buddies, and do not depend on instant messenger presence state.

In the Advisory Action, the Examiner refers to FIG. 8 of Aravamudan as disclosing "selective processing of messages according to states which correspond to an online user." However, as noted above, the state which Aravamudan takes into account is network state, which is entirely distinct from presence state of an instant messenger.

Because Aravamudan fails to disclose numerous features of claim 1 as set forth above, Aravamudan cannot be said to anticipate claim 1. Similar arguments apply to similar independent claims 20 and 39. For at least these reasons, Appellant submits that the rejection of claims 1, 20, and 39 is unsupported. Appellant notes that the remaining cited references fail to remedy the omissions of Aravamudan with respect to the independent claims.

**Claims 11, 17, 30, 36, 49, and 55:**

Regarding claim 11, Aravamudan fails to teach or suggest a method comprising storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.

In rejecting claim 11, the Examiner asserts that Aravamudan, col. 8, line 32 – col. 9, line 44 discloses the recited claim features. Appellant traverses the Examiner’s assertion for at least the following reasons.

**1. Aravamudan does not disclose storing an instant messaging operation associated with a given presence state, where the presence state corresponds to an online user.**

As discussed above, the cited passage of Aravamudan describes a situation in which an “important event” is received. The Examiner asserts that Aravamudan’s statement that “[i]mportant events include any data, communication, or notification received for the user” implies that an important event can be an instant messaging operation. Appellant traverses the Examiner’s assertion and reiterate that as noted above, Aravamudan describes numerous different types of events that could corresponding to “important events” without mentioning instant messaging operations among them. When taken as a whole, it is clear from this passage that Aravamudan is discussing the generation of an instant message in response to detecting some other type of event.

Since the “important event” that triggers generation of an instant message in Aravamudan is clearly some event other than an instant message, the fact that the important event may be “held in abeyance” is immaterial to claim 11’s requirement that it is the instant messaging operation that is stored, rather than some other event that triggers an instant message. Moreover, Appellant notes that Aravamudan discloses that the important event is held in abeyance in response to determining that the user is offline. Aravamudan, col. 8, lines 56-57. This is the **opposite** of claim 11’s requirement that the instant messaging operation that is stored be associated with a presence state that corresponds to an online user.

**2. Aravamudan fails to disclose performing the stored instant messaging operation in response to detecting a transition to the given presence state.**

As noted above, Aravamudan's "important event" held in abeyance is not a stored instant messaging operation, but at most a stored event of some other type that may trigger an instant message. Aravamudan discloses that "[t]he CSP then initiates an instant message to the user only when the status of the user is once again registered as online." Aravamudan at col. 9, lines 5-7, emphasis added. That is, in Aravamudan, no instant message is even generated in response to the pending event until the user is once again online. Thus, Aravamudan does not disclose performing an instant messaging operation that was stored in association with a given presence state prior to detecting a transition to that given presence state. Rather, Aravamudan discloses generating an instant message only when the user is once again online. The sequence of operations disclosed by Aravamudan is thus substantially different from that required by claim 11.

Because Aravamudan fails to disclose numerous features of claim 11 as set forth above, Aravamudan cannot be said to anticipate claim 11. Similar arguments apply to similar independent claims 30 and 49. Appellant therefore submits that the rejections of claims 11, 30, and 49 are unsupported. Appellant notes that the remaining cited references fail to remedy the omissions of Aravamudan with respect to the independent claims.

### **Third ground of rejection:**

The Examiner rejected claims 6, 25, and 44 under 35 U.S.C. § 103(a) as being unpatentable over McDowell in view of Generous et al. (U.S. Patent Application Publication No. 2002/0120697) [hereinafter Generous]. Appellant traverses this rejection and submit that it is unsupported for the reasons given above with respect to the claims from which claims 6, 25, and 44 depend. Appellant notes that Generous fails to remedy the omissions of the other cited references with respect to the independent claims.

## CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-57 was erroneous, and reversal of this decision is respectfully requested.

The Commissioner is authorized to charge the appeal brief fee of \$510.00 and any other fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5861-69900/AMP.

Respectfully submitted,

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Date: January 29, 2008

## VIII. CLAIMS APPENDIX

The claims on appeal are as follows.

1. A computer-implemented method, comprising:

receiving an instant messaging operation directed to a given user, wherein said given user is not offline;

determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and

selectively processing said instant messaging operation dependent upon said presence state in response to said determining.

2. The method as recited in claim 1, wherein said instant messaging operation comprises a chat operation.

3. The method as recited in claim 1, wherein said instant messaging operation comprises an alert operation.

4. The method as recited in claim 1, wherein said instant messaging operation comprises a poll operation.

5. The method as recited in claim 1, wherein selectively processing said instant messaging operation dependent upon said presence state further comprises:

notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and

queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state.

6. The method as recited in claim 5, wherein said instant messaging operation is a chat operation initiated by a second user, and wherein queuing said instant messaging operation without notifying said given user further comprises notifying said second user of said queuing.

7. The method as recited in claim 5, further comprising:

detecting a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and

notifying said given user of a queued instant messaging operation in response to detecting said transition.

8. The method as recited in claim 1, further comprising:

detecting a computer system activity level indicative of computer system activity;

determining whether said activity level exceeds an activity threshold in response to said detecting; and

transitioning said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

9. The method as recited in claim 1, further comprising:

storing schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time;

querying said schedule information; and

if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.

10. The method as recited in claim 1, further comprising:

storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to said given user;

detecting a transition to said given presence state subsequent to said storing; and

performing said instant messaging operation in response to said detecting.

11. A computer-implemented method, comprising:

storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user;

detecting a transition to said given presence state subsequent to said storing; and

performing said instant messaging operation in response to said detecting.

12. The method as recited in claim 11, wherein said instant messaging operation comprises a chat operation.

13. The method as recited in claim 12, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said chat operation.

14. The method as recited in claim 11, wherein said instant messaging operation comprises an alert operation.

15. The method as recited in claim 14, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said alert operation.

16. The method as recited in claim 11, wherein said instant messaging operation comprises a poll operation.

17. The method as recited in claim 11, further comprising:

detecting a computer system activity level indicative of computer system activity;

determining whether said activity level exceeds an activity threshold in response to said detecting; and



transitioning said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

18. The method as recited in claim 11, further comprising:

storing schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time;

querying said schedule information; and

if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.

19. The method as recited in claim 11, further comprising:

receiving an instant messaging operation directed to said given user, wherein said given user is not offline;

determining a presence state of said instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and

selectively processing said instant messaging operation dependent upon said presence state in response to said determining.

20. A computer-accessible storage medium, comprising program instructions, wherein the program instructions are computer-executable to:

receive an instant messaging operation directed to a given user, wherein said given user is not offline;

determine a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and

selectively process said instant messaging operation dependent upon said presence state in response to said determining.

21. The computer-accessible storage medium as recited in claim 20, wherein said instant messaging operation comprises a chat operation.

22. The computer-accessible storage medium as recited in claim 20, wherein said instant messaging operation comprises an alert operation.

23. The computer-accessible storage medium as recited in claim 20, wherein said instant messaging operation comprises a poll operation.

24. The computer-accessible storage medium as recited in claim 20, wherein selectively processing said instant messaging operation dependent upon said presence state further comprises:

notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and

queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state.

25. The computer-accessible storage medium as recited in claim 24, wherein said instant messaging operation is a chat operation initiated by a second user, and wherein queuing said instant messaging operation without notifying said given user further comprises notifying said second user of said queuing.

26. The computer-accessible storage medium as recited in claim 24, wherein said program instructions are further computer-executable to:

detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and

notify said given user of a queued instant messaging operation in response to detecting said transition.

27. The computer-accessible storage medium as recited in claim 20, wherein said program instructions are further computer-executable to:

detect a computer system activity level indicative of computer system activity;

determine whether said activity level exceeds an activity threshold in response to said detecting; and

transition said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

28. The computer-accessible storage medium as recited in claim 20, wherein said program instructions are further computer-executable to:

store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time;

query said schedule information; and

if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.

29. The computer-accessible storage medium as recited in claim 20, wherein said program instructions are further computer-executable to:

store an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to said given user;

detect a transition to said given presence state subsequent to said storing; and

perform said instant messaging operation in response to said detecting.

30. A computer-accessible storage medium, comprising program instructions, wherein the program instructions are computer-executable to:

store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user;

detect a transition to said given presence state subsequent to said storing; and

perform said instant messaging operation in response to said detecting.

31. The computer-accessible storage medium as recited in claim 30, wherein said instant messaging operation comprises a chat operation.

32. The computer-accessible storage medium as recited in claim 31, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said chat operation.

33. The computer-accessible storage medium as recited in claim 30, wherein said instant messaging operation comprises an alert operation.

34. The computer-accessible storage medium as recited in claim 33, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said alert operation.

35. The computer-accessible storage medium as recited in claim 30, wherein said instant messaging operation comprises a poll operation.

36. The computer-accessible storage medium as recited in claim 30, wherein said program instructions are further computer-executable to:

detect a computer system activity level indicative of computer system activity;

determine whether said activity level exceeds an activity threshold in response to said detecting; and

transition said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

37. The computer-accessible storage medium as recited in claim 30, wherein said program instructions are further computer-executable to:

store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time;

query said schedule information; and

if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.

38. The computer-accessible storage medium as recited in claim 30, wherein said program instructions are further computer-executable to:

receive an instant messaging operation directed to said given user, wherein said given user is not offline;

determine a presence state of said instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and

selectively process said instant messaging operation dependent upon said presence state in response to said determining.

39. A system, comprising:

a computer system;

an instant messenger software module configured to execute on said computer system;

wherein said instant messenger software module is further configured to:

receive an instant messaging operation directed to a given user, wherein said given user is not offline;

determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and

selectively process said instant messaging operation dependent upon said presence state in response to said determining.

40. The system as recited in claim 39, wherein said instant messaging operation comprises a chat operation.

41. The system as recited in claim 39, wherein said instant messaging operation comprises an alert operation.

42. The system as recited in claim 39, wherein said instant messaging operation comprises a poll operation.

43. The system as recited in claim 39, wherein selectively processing said instant messaging operation dependent upon said presence state further comprises:

notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and

queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state.

44. The system as recited in claim 43, wherein said instant messaging operation is a chat operation initiated by a second user, and wherein queuing said instant messaging operation without notifying said given user further comprises notifying said second user of said queuing.

45. The system as recited in claim 43, wherein said instant messenger software module is further configured to:

detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and

notify said given user of a queued instant messaging operation in response to detecting said transition.

46. The system as recited in claim 39, wherein said instant messenger software module is further configured to:

detect a computer system activity level indicative of computer system activity;

determine whether said activity level exceeds an activity threshold in response to said detecting; and

transition said presence state of said instant messenger software module to a busy state in response to determining that said activity level exceeds said activity threshold.



47. The system as recited in claim 39, wherein said instant messenger software module is further configured to:

store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time;

query said schedule information; and

if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.

48. The system as recited in claim 39, wherein said instant messenger software module is further configured to:

store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to said given user;

detect a transition to said given presence state subsequent to said storing; and

perform said instant messaging operation in response to said detecting.

49. A system, comprising:

a computer system;

an instant messenger software module configured to execute on said computer system;

wherein said instant messenger software module is further configured to:

store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user;

detect a transition to said given presence state subsequent to said storing; and

perform said instant messaging operation in response to said detecting.

50. The system as recited in claim 49, wherein said instant messaging operation comprises a chat operation.

51. The system as recited in claim 50, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said chat operation.

52. The system as recited in claim 49, wherein said instant messaging operation comprises an alert operation.

53. The system as recited in claim 52, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said alert operation.

54. The system as recited in claim 49, wherein said instant messaging operation comprises a poll operation.

55. The system as recited in claim 49, wherein said instant messenger software module is further configured to:

detect a computer system activity level indicative of computer system activity;

determine whether said activity level exceeds an activity threshold in response to said detecting; and

transition said presence state of said instant messenger software module to a busy state in response to determining that said activity level exceeds said activity threshold.

56. The system as recited in claim 49, wherein said instant messenger software module is further configured to:

store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time;

query said schedule information; and

if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.

57. The system as recited in claim 49, wherein said instant messenger software module is further configured to:

receive an instant messaging operation directed to said given user, wherein said given user is not offline;

determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and

selectively process said instant messaging operation dependent upon said presence state in response to said determining.

## **IX. EVIDENCE APPENDIX**

No evidence submitted under 37 CFR §§ 1.130, 1.131 or 1.132 or otherwise entered by the Examiner is relied upon in this appeal.

**X.     RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.